REMARKS

The claims have been subjected to a restriction requirement under 35 U.S.C. §121 which requires an election between Group I containing Claims 1-6 drawn to a process for converting hydrocarbons and Group II containing Claims 7-17 drawn to a process for the Isomerization of paraffin feedstock. Applicants hereby affirm their provisional election to prosecute Group I containing Claims 1-6 and have cancelled the non-elected Claims 7-17. Furthermore, Claim 2 is directed to a process selected from the group consisting of cracking, hydrocracking, aromatic alkylation, isoparaffin alkylation, isomerization, polymerization, reforming, dewaxing, hydrogenation, dehydrogenation, transalkylation, dealkylation, hydration, dehydration, hydrotreating, hydrodenitrogenation, hydrodesulfurization, methanation, ring opening, and syngas shift and applicants have been required to select a single disclosed species for prosecution on the merits. Applicants affirm the telephonic election of isomerization as the selected species, and all claims read on this selected species. Claim 6 has been amended to correct a typographical error.

Claims 1-6 stand rejected under 35 U.S.C. §112, second paragraph, as failing to particularly point out and distinctly claim the subject matter that applicants regard as their invention. Specifically the Official Office Action states that the claims do not recite any positive limitations, process steps, process parameters, or process conditions. Applicants traverse the rejection and assert that amended Claim 1 recites a process step and thereby meets the requirements of 35 U.S.C. §112. Claim 1 has been amended to clarify that the process step is: "contacting a feed with a solid acid catalyst, comprising a support comprising a sulfated oxide or hydroxide of at least an element of Group IVB (IUPAC 4) of the Periodic Table, a first component selected from the group consisting of at least one lanthanide-series element, mixtures thereof, and yttrium, and a second component selected from the group of platinum-group metals and mixtures thereof, to give a converted product." Having one process step fulfills the statutory requirements, and the amendment to Claim 1 clarifies applicants' process step. No new matter has been added by the amendment.

Claims 1-2 and 4-6 stand rejected under 35 U.S.C. §102(e) as being anticipated by Marella et al. It is noted that dependent Claim 3 was not rejected under 35 U.S.C. §102(e)

and therefore the limitations of dependent Claim 3 have been incorporated into independent Claim 1. The Marella et al. reference does not teach that in the solid acid catalyst the atomic ratio of the first component to the second component is at least about 2 where the first component is selected from the group consisting of at least one lanthanide-series element, mixtures thereof, and yttrium, and the second component selected from the group of platinum-group metals and mixtures thereof. With the Marella et al. reference failing to teach the claimed atomic ratio of amended Claim 1 and dependent claims, applicants respectfully ask that the rejection to the claims promulgated under 35 U.S.C. §102(e) be withdrawn.

Claim 3 stands rejected under 35 U.S.C. §103 as being unpatentable over Marella et al. Applicants traverse the rejection and assert that Marella et al. fails to teach, suggest, or provide motivation of applicants' invention as claimed and that a *prima facie* case of obviousness has not been established. Absent applicants' own disclosure, there is nothing in the cited references that would teach or suggest applicants' invention as claimed.

The Marella et al. reference does not include teachings or suggestions as to successful atomic ratios of the lanthanide-series element(s) or yttrium to the platinum-group metal(s) as claimed in applicants' amended Claim 1. The Official Office Action states that it would have been obvious for one to determine, through routine experimentation, the optimal amounts of, for example, lanthanides, yttrium, precious metals to obtain a solid acid catalyst having applicants' atomic ratio. The Official Office Action cites In Re Boesch, 617 F2d 272, 205 USPQ 215 (CCPA 1980) as authority for the position that discovering an optimum value of a result effective variable involves only routine skill in the art. However, the holding of In Re Boesch is directed to metal alloys and not to subject matter within the catalytic arts. Applicants' invention is within the catalytic arts, which has long been held to be an unpredictable art. Therefore, it is not obvious from the Marella et al. reference that routine experimentation based on Marella et al teachings would result in applicants' invention. Furthermore, at most, the Marella et al. reference provides that the cited components would be "obvious to try" in different ratios as catalyst components. But "obvious to try" is not the proper standard to support a rejection under 35 U.S.C. §103(a)

and the established unpredictability of the catalytic art precludes applicants' particular limitation of the atomic ratio from being obvious to one of ordinary skill in the art.

Accordingly, in view of the above amendments and remarks, this application is now believed to be in a condition for an allowance of all remaining claims and such action is respectfully requested.

Respectfully submitted,

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